

### **REMARKS**

Applicant has carefully reviewed the Final Office Action mailed on January 12, 2004. Favorable reconsideration is respectfully requested in light of the above amendments and the following comments.

Applicant respectfully traverses the Examiner's rejection of claims 37-42 under 35 U.S.C. § 103(a) as unpatentable over Gambale et al., U.S. Patent No. 4,922,924. Rather, claims 37-42 are indeed patentable over the cited reference.

The Examiner has asserted that Gambale et al. teach a plurality of radiopaque markers spaced apart by turnings of a non-radiopaque coil interspersed within a radiopaque coil. It is true that Gambale et al. teach a radiopaque coil and a non-radiopaque coil, with the turnings of each interspersed in alternating fashion. However, it is untrue that Gambale et al. teach radiopaque markers that are spaced apart.

Rather, Gambale et al. teach intertwining a non-radiopaque coil within the windings of a proximal portion of a radiopaque coil in order to make that portion of the radiopaque coil less radiopaque. As a result, the portion of the guidewire having the non-radiopaque coil turnings interspersed with the radiopaque coil turnings will appear gray on a fluoroscope. See, for example, column 3, lines 16-25. Because the proximal portion is only moderately shaded, it is possible to visualize other aspects of the blood vessel proximate the proximal portion when contrast fluid is present.

As noted, Gambale et al. teach a proximal portion that appears gray on a fluoroscope. Because the radiopaque coil is a continuous helix, no distinct markers appear. One of ordinary skill in the art, having read the instant specification and claims, would understand, in this context, the term "marker" to refer to something that will be distinctly visible on a fluoroscope or other appropriate imaging technology. In the claimed invention, a plurality of radiopaque markers are disposed on the guidewire shaft, with a longitudinal space between each radiopaque marker. This means that upon appropriate visualization, each marker is clearly visible as such and defines a visible space between two adjacent markers. Because the markers are distinctly and visibly separated by the claimed spacing, they can be used as discussed in previous responses to monitor and control device deployment within the patient's vasculature. Gambale et al. do not teach the claimed invention. Favorable reconsideration is respectfully requested.

Applicant respectfully traverses the Examiner's rejection of claims 37-42 under the judicially created doctrine of obviousness-type double patenting over claims 1, 5-7, 9 and 10 of U.S. Patent No. 6,179,788. Applicant notes that the pending application is a continuation of the aforementioned patent, and thus the normal patent term of any patent issuing therefrom, apart from any possible term adjustment issues, is already considered to be limited to that of the parent. Thus, an appropriate Terminal Disclaimer is filed simultaneously with this Response. Applicant does not concede the correctness of the rejection.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

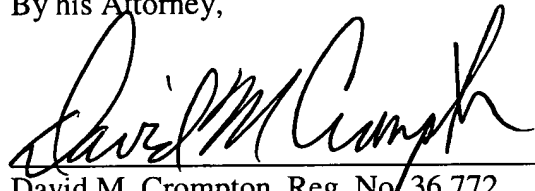
Respectfully submitted,

Daniel J. Sullivan

By his Attorney,

Date: \_\_\_\_\_

5/12/04



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